

Appl. No. 09/914,492  
Atty. Docket No. CM2045  
Amdt. dated 7/28/2003  
Reply to Office Action of 1/28/2003  
Customer No. 27752

## REMARKS

### Application Amendments

Claim 1 has been amended as shown above. Claim 9 has been deleted. Support for the amendment to claim 1 can be found at deleted claim 9. No new matter has been included in the amended claims.

### The Examiner's Claim Rejections under 35 USC § 103(a)

#### 1. Kimura et al. US 5690916, Dietz et al. US 6132873 and JP 57098205 A (Pola Abstract)

The Examiner has rejected claims 1-17 under 35 USC § 103(a) as being unpatentable over Kimura et al (US 5,690,916) and Dietz et al (US 6,132,873) further in light of Pola (JP57098205).

In order to establish a prima facie case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of skill in the art, to modify the reference or to combine reference teachings. Second there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The instant claims, as amended, are written to topical compositions comprising:

- e) from 0.1% to 10% of an organic particulate material having a refractive index of from 1.3 to 1.7, the particulate material being dispersed in the composition and having a volume average particle size in the range of from about 10 to about 30  $\mu\text{m}$ ;
- f) from about 0.05% to about 2.5% by weight of a green, platelet-type interference pigment material having a  $\text{TiO}_2$  layer thickness of from about 120nm to about 160nm;
- g) from about 0% to about 3% of an inorganic matting agent; and
- h) a dermatologically acceptable, topical carrier.

Kimura, on the other hand, discloses materials having as a transmitted light component, a color gamut which is a complementary color for the skin color to be adjusted, or a color which is close to that complementary color, the transmitted light component being

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compounded into a skin color adjusting composition. Also disclosed are fine particles of iron oxide having an average particle diameter of 10-150 nm which is coated on the titanium oxide coated mica.

Kimura does not teach or suggest the use of porous, organic particles. The nylon particles of Kimura are globular nylon particles that are not disclosed as being porous. The present invention composition contains spherical porous, organic particles as now claimed in claim 1. Applicants have determined that the spherical porous, organic powders of the present invention reduce the sticky/tacky feel brought on by the instant compositions high levels of humectant and the presence in them of niacinamide. The spherical porous powder has a ball bearing effect, such that the composition rolls on the skin during application providing a silky smooth feel.

In addition, the size of the nylon particles of the instant compositions was chosen carefully. The powders of the Kimura reference are larger in size and, well known to those of skill in the art, would produce a grainy product that results in a product that does not produce a smooth feel upon application.

Dietz does not disclose the use of any porous organic particles in combination with its multilayered interference pigments that are useful in paints, printing inks, plastics, glazes for ceramics, glass and cosmetics. As discussed above, Applicants have determined that the spherical nylon powders reduce the sticky/tacky feel brought on by the instant high levels of humectant or the presence of niacinamide. The improvements in skin feel are important to the present invention and Dietz does not teach or suggest the use of spherical porous nylon particles, nor in fact, any type of organic particle, as specified by the instant claims. One of ordinary skill in the art would have no motivation to use the particles of the present invention since Dietz does not disclose any type of particle.

Combining the teachings of Kimura with the teachings of Dietz would not render the Applicants' presently claimed invention obvious. Specifically, the references do not teach or suggest a topical composition containing 0.05% to about 2.5% of interference pigments and 0.1% to 10% of a spherical porous organic particle as in the present invention. Assuming that one having ordinary skill in the art would combine the disclosures of Kimura and Dietz, one would still fall short of the Applicants' claimed invention only to arrive at a composition that

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when applied to the skin, leaves too much residue and gives the skin an artificial look, a composition that is grainy and abrasive, and not smooth during application.

Additionally, the Examiner states that the skilled artisan would have been further motivated to substitute the globular nylon powder for the spherical porous powder as suggested by the Pola abstract because of the expectation of successfully producing a cosmetic composition which provides longer cosmetic activity and good skin feel. The Office Action discounts the impact of the specific particle size and refractive index characteristics of the instant porous organic particles, but in the cosmetic arts significant contributions are made by selection of components which result in superior physical characteristics.

Combining the teachings of Kimura with the teachings of Dietz and Pola would not render the Applicants' presently claimed invention obvious. Specifically, the references do not teach or suggest a topical composition containing 0.05% to about 2.5% of interference pigments and 0.1% to 10% of an organic particulate material are porous, organic and spherical and have a refractive index of 1.3 to 1.7. Assuming *arguendo* that one having ordinary skill in the art would combine the disclosures of Kimura, Dietz and Pola, one would still fall short of the Applicants' claimed invention only to arrive at a composition that is applied to the face, leaves too much residue and gives the skin an artificial look, a composition that is grainy and abrasive and not smooth during application, and does not match the refractive index of the skin. The references fail to teach or suggest each and every element of Applicants' presently claimed invention.

2. Kimura et al. US 5690916, Dietz et al. US 6132873 and JP 57098205 A (Pola Abstract) and further in view of Nishimura et al. (JP 410194944 A, English Abstract of JP 10194944 A) and Mathur US 4096240

The essence of the instant invention lies in the use of the porous organic particulate material in combination with the green, platelet type interference pigments. Therefore, the addition of Nishimura, which teaches anatase-type titanium dioxide as an ultraviolet light protecting agent in cosmetics is not germane to the patentability of the instant invention. In a similar manner, neither Mizugushi which teaches the process of coating anatase type titanium dioxide with silica, nor Mathur, which utilizes niacinamide to lighten skin do not make the instant claims obvious. If all three of these references, alone or in combination with the

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initial three references of Kimura, Dietz and Pola, were given to one of skill in the art and he/she was instructed to produce products combining their teachings, many compositions would result, but none would be those of the Applicants.

Accordingly, the Examiner has not presented a prima facie case of obviousness and Claims 1-8 and 10-17 of the present invention are nonobvious over the prior art of record. Reconsideration and withdrawal of the rejection on this basis are requested.

### CONCLUSION

In light of the remarks and amendments, Applicants respectfully submit that the applied reference does not disclose or render obvious Claims 1-8 and 10-15. Accordingly, favorable reconsideration of Claims 1-8 and 10-15 is earnestly solicited in the form of a Notice of Allowance.

Should any issues impeding continuing examination of this Application remain, the Examiner is encouraged to contact the undersigned by telephone at the earliest possible date to achieve a timely resolution.

Respectfully submitted

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